

REMARKS

The Examiner and Supervisory Examiner Thomas are thanked for the interview conducted on July 20, 2006 and for accommodating the undersigned's schedule.

In the June 9, 2006 Final Office Action, claims 1-42 stand rejected under 35 USC § 103(a) for obviousness over United States Patent No. 5,950,169 to Borghesi et al. ("Borghesi") in view of a "PR Newswire" article dated March 21, 2001 ("PR Newswire"). In view of the following remarks, Applicants respectfully request reconsideration of all of the Examiner's rejections and allowance of the pending claims. Alternatively, Applicants respectfully request withdrawal of the finality of the Office Action due to its ambiguity and lack of support for the recited obviousness rejections, and issuance of a non-final Office Action with a detailed explanation of the reasoning behind the pending obviousness rejections and the specific instances in the cited references which support a *prime facie* case of obviousness of claims 1-42.

With respect to the respective obviousness rejections of independent claims 1, 15, 26, 32, 33, and 39, independent claim 1 is generally representative of rejected independent claims 1, 15, 26, and 32. Independent claim 1 is directed to a method of processing vehicle damage claims, comprising the steps of: reporting a vehicle damage claim to an insurance provider by a claimant; delivering a damaged claimant vehicle to an insurer facility operated by the insurance provider; preparing a repair estimate at the insurer facility by a representative of the insurance provider; selecting a repair facility, with the repair facility selected by the insurance provider; repairing the damaged claimant vehicle at the repair facility; returning the repaired claimant vehicle to the insurer facility; and returning the repaired claimant vehicle to the claimant. As previously amended, independent claim 1 sets forth that the step of selecting a repair facility is conducted by the insurance provider without input from the claimant. Additionally, the method step of returning a repaired claimant vehicle to the insurer facility was previously further described as being conducted without input from the claimant. The clarifying language previously added to independent claims 1, 15, 26, and 32 more distinctly indicates that the step of selecting a repair facility is done actively by the insurance provider alone and, thus, without input from the claimant/customer.

As indicated, independent claims 1, 15, 26, 32, 33, and 39 stand rejected over Borghesi in view of PR Newswire. Borghesi is discussed in the background section of the application and discloses a system and method for managing insurance claims that includes a

computer network. The computer network controls the electronic transmission of files between various computers. Computers may be located at disparate locations including parts supply vendors, repair shops, salvage yards, insurance company offices, and other locations that may be involved in an insurance claim processing situation. When a claim is filed, the claim is entered as a work file in the system. The different computers in the network may access the work file to enter certain information in the work file which is then accessible by all the computers of the network. For example, a repair shop may be entered into the work file for cost estimates, both labor and parts, for repairing a particular vehicle. The work file may also contain vehicle information describing the vehicle, identification number, year, make, model, and other pertinent information about the vehicle.

In paragraph 7 of PR Newswire, it is stated that the website, *progressive.com*, includes a repair facility locator service which is provided to give the claimant/customer the ability to shop for repair facilities for a damaged vehicle. In other words, the claimant/customer is provided with a list of repair facilities, from which the claimant/customer may select a repair facility and takes his or her car thereto. Of course, the claimant/customer may also select a repair facility that is not on the list. The claimant/customer may learn of such a facility from the yellow pages or advertisements, recommendations from friends, family or colleagues, or prior experiences. In the PR Newswire, the claimant/customer retains full responsibility for selecting a repair shop and arranging for, contracting for and retaining repair. The present invention differs from the PR Newswire in that the insurer, instead of the claimant/customer, assumes responsibility for all of the above items.

Turning to the merits of the obviousness rejections, in paragraph 4A of the Office Action rejecting independent claims 1 and 15, column 13, lines 24-33 of Borghesi are recited verbatim. Thereafter, it is flatly concluded that the “recited claimed features are rejected for the same reasons given in the prior Office Action”, dated September 15, 2005. However, in the previous Office Action, this section or passage from Borghesi was not cited against any claim. Accordingly, independent claims 1 and 15 are rejected for obviousness without explanation or specific application of the cited prior art against any of the claim limitations in independent claims 1 and 15. At best, this specific passage of Borghesi teaches that an authorized individual has access to the computer network; but this bears no relation to the subject matter set forth in independent claims 1 and 15, wherein one or more of the recited method steps is accomplished without input from the claimant, but instead by the insurance provider alone. The addition of

the PR Newswire reference does not correct any of the deficiencies of Borghesi as pointed out in Applicants' January 19, 2006 Amendment and specifically does not correct the deficiencies of the latest passage to be cited from Borghesi. The limit of the PR Newswire disclosure is for teaching a repair facility locator service on a website, *progressive.com*. While this service is convenient to provide the claimant/customer with the ability to shop for repair facilities for a damaged vehicle, it is clear from the PR Newswire that it is the claimant/customer who selects the repair shop and arranges for repair. From this teaching, one cannot extrapolate a system in which the insurance provider selects a repair facility for repair of the claimant/customer vehicle and arranges for and monitors the entire repair process, all without input from the claimant/customer. In actuality, as the website is specifically intended to be accessed by the claimant/customer to shop for a repair facility, this repair facility locator service necessarily requires the input of the claimant/customer which is contrary to the language in independent claims 1 and 15 and, thus, contrary to the language of each of independent claims 26 and 32 as well. Providing such a repair facility locator service on the *progressive.com* website in actuality teaches away from the claim language in independent claim 1, as an example, wherein the repair facility is selected by the insurance provider, not the claimant/customer.

In neither Office Action to date has *prime facie* case of obviousness been set forth regarding independent claims 1, 15, 26, and 32. In actuality, this latest Office Action cites new sections of Borghesi that are no more relevant than the sections cited in the previous Office Action and again adds the PR Newswire reference which adds nothing to the obviousness rejections. As indicated, at most the PR Newswire reference discloses a common repair facility locator service without explaining how this reference, or the combination of Borghesi and PR Newswire, yields the limitations set forth in the pending independent claims. A general conclusion as in the Office Action that Borghesi and PR Newswire correspond to Applicant's claimed features is not sufficient reasoning to support a *prime facie* case of obviousness. Rather, this is a conclusion arrived at without specific reasoning. More importantly, nowhere in either cited references is there a teaching or suggestion of an insurance provider selecting a repair facility without input from the claimant/customer with the vehicle thereafter repaired and returned to the insurance provider facility without input from the claimant/customer as detailed previously in Applicants' January 17, 2006 Amendment.

For the foregoing reasons, Applicants respectfully submit that the obviousness rejections in the Office Action fail to meet the threshold requirements for a *prime facie* case of

obviousness as the recited rejections are mere conclusions, lacking any substance or reasoning leading to the conclusions. Applicants are, in effect, unable to appropriately respond to the Office Action other than by speculating as to what the components of the obviousness rejections could be because no specific nexus is provided between the teachings of Borghesi and/or PR Newswire and the claim limitations in the independent claims. It is noted that paragraphs 4B and 4C are essentially repeats of paragraph 4A and do not provide any further explanation of the rejections. Accordingly, the foregoing comments regarding independent claims 1 and 15 are equally applicable to the obviousness rejections of independent claims 26 and 32 in paragraphs 4B and 4C of the Office Action.

Finally, it is noted that independent claims 33 and 39 were not addressed in the Office Action even though these claims were properly added by Preliminary Amendment filed on August 8, 2005. Independent claims 33 and 39 are merely lumped in with claims 1-42 in paragraph 4 of the Office Action even though these claims are apparatus claims and differ in substance from independent method claims 1, 15, 26, and 32.

In view of the foregoing, Applicants respectfully request reconsideration of the Examiner's rejections and allowance of rejected claims 1-42. In the alternative, Applicants respectfully request withdrawal of the finality of the Office Action due to its ambiguity and lack of support for a *prime facie* case of obviousness of claims 1-42 over the cited references.

If the Examiner or Supervisory Patent Examiner Thomas wishes to discuss the foregoing claim amendments and cited references further, he is invited to contact the undersigned at the telephone number provided.

Respectfully submitted,

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